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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,934	05/03/2000	ANDREAS STEINMEYER	SCH1747	6707

7590

01/18/2002

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 01/18/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,934

Applicant(s)

Steinmeyer et al.

Examiner

Sabiha Qazi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 4, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, and 8-30 is/are pending in the application.
- 4a) Of the above, claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, and 14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 12 and 13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1616

Final Office Action on Merits

Status of the Application

Claims 1-29 are pending.

Claims 1-3, 5-6, 8-11 and 14-30 are rejected.

Claims 12 and 13 are withdrawn from consideration as non elected invention.

Rejection under 102 (b) is withdrawn because arguments were found persuasive, other rejections are maintained for the same reasons as set forth in our previous office actions. Applicant's arguments regarding double patenting and 103 rejections were fully considered but are not found persuasive.

Applicant argue that prior art teaches the cyclopropyl group at 24 position whereas instant claims are claiming at 25-position. Examiner respectfully disagree because instant invention is claiming Q which can be alkyl group which can have OH at any position which in turn can be etherified or esterified, keto groups, amino groups or halogens (see definition of Q in claim 1).

Claims 1-3, 5-6, 8-11 and 14-30 stand rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,585,368 and claims 1-9 of US Patent 5,700,791 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, for the same reasons as discussed in our 103 rejection. Instant invention is drawn to the vitamin D derivatives which are considered obvious over the claims of the prior US Patent issued to the same inventor and same assignee.

Art Unit: 1616

Claims 1-3, 5-6, 8-11 and 14-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsh et al. (WO 97/00242) for the same reasons as set forth in our previous office action. See the entire document especially formula I on page 1, example XXXIV on page 36. Kirsh et al teaches 25-substituted vitamin D derivatives, their process of making and method of use.

Instant claims differ from the reference in claiming a limited genus than the prior art. A cyclopropyl ring is the only substituent at 25 position whereas prior art teaches 3-7 membered carbocyclic or heterocyclic ring and other groups at the same position.

It would have been obvious to one skilled in the art at the time of the invention to prepare additional beneficial compounds and their compositions for medicinal use by selecting cyclopropyl ring at 25-position. This would have been obvious because 3-7 carbon cyclic rings at the same position has been taught by the prior art. Instant invention is the selection of prior art teachings. There has been ample motivation provided by the prior art to prepare the instant invention.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

Art Unit: 1616

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Sabiha N. Qazi, Ph.D.

Primary Examiner

Art Unit 1616

1/17/02